

## Office Action Summary

Application No.

09/556,839

Applicant(s)

MAWLE ET AL.

Examiner

Alex P. Rada

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34-39 is/are allowed.
- 6) ☒ Claim(s) 1-33 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>14</u> . | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION*****Response to Amendment***

In response to the amendment filed March 16, 2004 in which the applicant submits arguments to the previous office action and claims 1-40 are pending in this office action.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of copending Application No. 10/067963. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-36 of the copending Application No. 10/067963 "anticipates" application serial number 09/556839 of claims 1-40. Accordingly, the application of claims 1-40 are/is not patentably distinct from copending Application No. 10/067963 of claims 1-36. Here, copending Application No. 10/067963 of claims 1-36 requires a toy figure, a first game system configured to communicate with the toy figure, a second game system configured to communicate with the toy figure while the application of claims 1-40 only

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requires elements toy figure, a first game system configured to communicate with the toy figure, a second game system configured to communicate with the toy figure, the first game system includes a first design, and the second game system includes a second design. Thus it is apparent that the more specific copending Application No. 10/067963 of claims 1-36 encompasses the application of claims 1-40. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 7-33, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Sharpe III* et al in view of *Gabai* et al, in view of *Gilboa* '327.

*Sharpe* in view of *Gabai* discloses all of the claimed limitations as discussed in the previous office actions (see papers #5 and #8), which are incorporated herein by reference. In response to the addition of the feature of providing a representation of the toy figure when the

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first and second game systems communicate with the toy, Gilboa teaches the feature of providing a representation of the toy figure when the toy figure is in communication with the game system (abstract; col.3, lines 15-43; col. 4, lines 19-20, lines 23-25 and lines 42-45). It would have been obvious to a person of ordinary skill in the art at the time of the invention to employ this feature, as taught by Gilboa, in Sharpe and Gabai to make the game more realistic and fun for smaller children.

Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Sharpe III* et al in view of *Gabai* et al, further in view of *Gilboa* ('327), further in view of *Kikinis*.

Regarding claims 4 and 6, Sharpe, Gabai and Gilboa, teach all the limitations of the claims as discussed above. Regarding the features of the mating connector and inductive or capacitive coupling connections, Kikinis teaches these features (see prior office action, paper #8, which is incorporated herein by reference). It would have been obvious to a person of ordinary skill in the art at the time of the invention was to incorporate these features as taught by Kikinis, in the game systems of Sharpe, Gabai and Gilboa, to enhance the communication between the gaming system and the toy figure; thereby improving game output.

### *Allowable Subject Matter*

The examiner maintains the reasons for allowance of claims 34-39 in the previous office action of paper number 16.

### *Response to Arguments*

3. Applicant's arguments filed March 16, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, the suggestion to combine can be found in the reference of Gilboa. The examiner agrees with applicant that Sharpe and Gabai do not provide a representation of a toy figure when the game system communicates with the toy figure. However, Gilboa was cited to teach the representation of a toy figure when the game system communicates with the toy figure (figure 2B and column 7, line 64 – column 8, line 4). The game system provides a communication to the toy by displaying a video sequence of a pond (18) interacting with the toy figure (16) represented on the display speaking about and/or interacting with the environment by providing sounds that represent the seen, thus providing a representation of a figure when the game system communicates with the toy figure (figure 2B and column 7, line 64 – column 8, line 4). By representing a toy figure when the game system communicates with the toy figure, one of ordinary skill in the art would provide a realistic representation for children. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to employ this feature, as taught by Gilboa, in Sharpe and Gabai to make the game more realistic and fun for smaller children.

The applicant contends that Kikinis does not provide a representation of a doll. The examiner agrees that the Kikinis computer never provides a representation of a doll. However the Kikinis reference was used to teach the limitation of the mating connector and inductive or capacitive coupling connections, in which Kikinis teaches these features (see prior office action, paper #8, which is incorporated herein by reference). It would have been obvious to a person of

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ordinary skill in the art at the time of the invention was to incorporate these features as taught by Kikinis, in the game systems of Sharpe, Gabai and Gilboa, to enhance the communication between the gaming system and the toy figure; thereby improving game output.

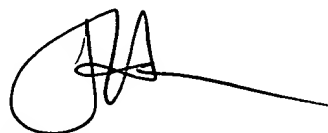
*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on 703-308-2217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
APR

  
JESSICA HARRISON  
PRIMARY EXAMINER